

REMARKS

Status of Claims

Claims 1-15 were under examination. Claims 8-11, 14 and 15 have been canceled. Thus, claims 1-7, 12 and 13 are currently under examination.

Claim Rejections Under 35 USC 112

Claims 1-9 have been rejected under 35 USC 112, first paragraph. The rationale given for the rejection can fairly be distilled down to the following: The specification enables the practice of the claimed invention using only some chiral carrier materials, not all possible chiral carrier materials, but the claims are not limited to use of the chiral carrier materials for which there is enabling disclosure.

Claims 1-9 have also been rejected under 35 USC 112, second paragraph. The rationale given is that the phrase “chiral carrier material” is indefinite.

It is respectfully asserted that the rejection of claims 1-9 has been overcome by the amendment of claim 1.

As amended, claim 1 is no longer directed to the use chiral carrier materials, without limitation. Rather, as amended, claim 1 is limited to a process wherein the chiral carrier material is selected from the group consisting of tris(3,5-dimethylphenylcarbamate)-amylose, tris[(S)- α -methylbenzylcarbamate]-amylose, tris(3,5-dimethyl-phenylcarbamate)-cellulose, tris(4-methylbenzoate)-cellulose, cellulose triacetate, cellulosetribenzoate, tris(phenylcarbamate)-cellulose, tris(4-chlorophenylcarbamate)-cellulose, cellulosetricinnamate and cellulosetribenzoate. These are the chiral carrier materials which the specification, at page 13, lines 9-15, indicates are specifically preferred by the applicants for the purpose of carrying out the claimed process. One skilled in the art would have no reason for doubting that these specifically preferred chiral carrier materials are workable or enabled, even though the specification may not contain a working example for each one. Unless the Examiner can adduce a sound

basis for doubting that each of these specific chiral carrier materials can be used to successfully carry out the claimed process the rejection of claim 1 under 35 USC 112, first paragraph, must be withdrawn. Further, claim 1 as amended is limited to a Markush group consisting of only nine specifically named chiral carrier materials. Clearly the rejection of claim 1 as being indefinite has been overcome.

Claims 2-7 depend from claim 1 and thus inherit the limitation which has been introduced into claim 1 by amendment. The rejections of claims 2-7 should be withdrawn for the same reasons given with respect to claim 1.

It is urged that claims 1-7 are allowable.

Claims 8 and 9 have been canceled, rendering their rejection moot.

Claim Rejections Under 35 USC 102 and 103

Claims 14 and 15 have been canceled, rendering their rejection moot.

Objections to Claims

Claims 10-13 have been objected to because of dependency from rejected claims 1 and 8.

Objection to claims 10 and 11 is rendered moot by the cancellation of these claims.

Claim 12 has been amended so that it now depends from claim 1 rather than claim 8.

It is respectfully urged that the basis for objection to claims 12 and 13 is overcome by the amendment of claim 1, which amendment has removed any basis for rejection of claim 1.

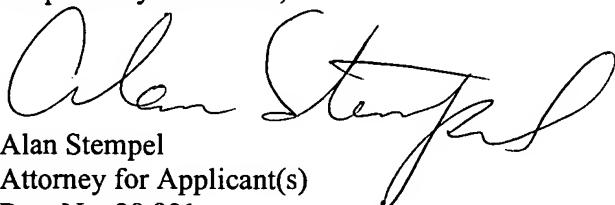
Supplemental Information Disclosure Statement

A supplemental Information Disclosure Statement by Applicant (PTO/SB/08) is submitted herewith.

The Examiner should note that one of the citations is to a web page, entitled "Online Guide to Chiral HPLC", which are identified by its URL (<http://www.raell.demon.co.uk/chem/CHIbook/Chiral.htm>). A printout of this web page, as they appeared on January 5, 2005, is provided as an enclosure. This web page has a copyright notice dated 1999. A private communication from the author of this web page has confirmed that it was in fact published via the Internet on April 8, 1999.

This Information Disclosure Statement is being filed after the time period specified in 37 C.F.R. §1.97(b), but before the mailing date of: i) a final action under 37 C.F.R. §1.113, ii) a notice of allowance under 37 C.F.R. §1.311, or iii) an action that otherwise closes prosecution in the application. The undersigned certifies that, upon information and belief, no item of information contained in the instant Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the undersigned, after making reasonable inquiry, no item of information contained in the instant information disclosure statement was known to any individual designated in 37 C.F.R. §1.56(c) more than three (3) months prior to the filing of the instant information disclosure statement.

Respectfully submitted,


Alan Stempel
Attorney for Applicant(s)
Reg. No. 28,991

Patent Department
Boehringer Ingelheim Corp.
900 Ridgebury Road
P.O. Box 368
Ridgefield, CT. 06877
Tel.: (203) 798-4868